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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91224533
Party	Defendant Dazzle Up, LLC
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Submission	Motion to Amend/Amended Answer or Counterclaim
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Date	10/10/2016
Attachments	Motion for Leave to Amend Counterclaim 10 10 2016 w Exs.pdf(504739 bytes)

)	
SIMPLY SOUTHERN FINE ARTS)	
AND HOME DÉCOR, LLC,)	Opposition No. 91224533
Opposer/Registrant,)	Application Serial No. 86/450,713
)	
v.)	Counterclaim Cancellation Petition
)	Registration No. 3,335,887
DAZZLE UP, LLC,)	
Applicant/Counterclaim)	
Petitioner.)	
)	

Dazzle Up, LLC (“Applicant”), by and through undersigned counsel, and pursuant to Fed. R. Civ. P. 15(a), 37 C.F.R. § 2.127(a), and TBMP §§ 502 & 507, hereby moves for leave to amend its Counterclaim.

In support of this motion and as its brief embodied in this motion, Applicant submits the following.

1

In the Counterclaim, Applicant seeks the cancellation of a registration, No. 3,335,887, which Opposer recently acquired in 2015 from a prior owner, Lawrence Taylor of Melbourne, Florida. The ground for cancellation asserted was that the prior owner, Mr. Taylor, had previously abandoned his rights in the registration. Indeed, during the course of offering to buy the registration, the attorney for Opposer (who is not its counsel in this case but who was also the husband and brother of the owners of Opposer) wrote that their research showed that the name appeared to be abandoned.

During discovery in this Opposition, Mr. Taylor and his wife were deposed on August 23, 2016 in Melbourne, Florida. They had until October 3, 2016 to correct their testimony, and they have not provided any corrections.

The Taylors testified to facts revealing that the services identified in the registration had never actually been rendered and thus the mark was never used in commerce with the identified services. Among other things, their testimony revealed that Mr. Taylor understood the services in the identification would mean only online ordering services through their website, but they never provided that online ordering service. Their website never permitted the online ordering of products. Further, they never had a retail store or provided retail ordering services. Additionally and materially, the specimen for the Statement of Use filed with the Patent and Trademark Office had never actually been used in commerce, the services were not being rendered when the Section 8 Declaration of Use was filed, and the mark had not been in continuous use with the services for five years after the date of registration and before the filing of the Declaration of Incontestability as the services were never rendered, much less for five years.

Their testimony demonstrates, among other things, that the services were never rendered in commerce, that the name in question was never used as a mark for rendering the identified

services, and that the filed specimen of use was just a draft and never actually used.¹ At most for the Taylors, the name in question might have been a mark for particular goods but certainly not a mark for the services identified in the registration. Further the testimony demonstrated that the sales of the products were so “minimal” that they were mere token sales insufficient to establish bona fide use in commerce. Their testimony further demonstrated that they knew these facts to be true and yet made multiple false, material representations in multiple filings at the Patent and Trademark Office, claiming falsely that they were using the mark with the identified services, with the intent and effect of deceiving the Patent and Trademark Office into both issuing the registration and then accepting the Section 8 & 15 Combined Declaration. This newly learned testimony demonstrates that fraud was committed both when the Statement of Use was filed on June 21, 2007 and the registration was issued, and then again when the Combined Declaration of Use and Incontestability under Sections 8 & 15 was filed on December 4, 2012.

The proposed amendment adds the ground of fraud to the cancellation counterclaim and conforms the claim to the evidence already obtained. The fraud is pled with specificity in the proposed amendment.

The Board “liberally grant[s] leave to amend at any stage of a proceeding when justice so requires, unless entry of the proposed amendment would be prejudicial to the rights of the adverse party or would violate settled law.” *Prosper Bus. Dev. Corp. v. International Business Machines, et al.*, 2014 TTAB LEXIS 354, *12-17, 113 USPQ2d 1148 (TTAB 2014). In deciding whether to grant leave to amend, a tribunal may consider undue delay, prejudice to the opposing party, bad faith or dilatory motive, futility of the amendment, and whether the party has previously amended

¹ In addition, their testimony was that Mr. Taylor was not substantively or operationally involved with the business, that he was only, at best, a “silent partner,” and that Mrs. Taylor made the filings in his name.

its pleadings. *See Foman v. Davis*, 371 U.S. 178, 182 (1962). In the non-precedential decision of *SaddleSprings, Inc. v. Mad Croc Brands, Inc.*, No. 92055493 (TTAB Mar. 31, 2014), the Board permitted amendment of a cancellation petition based upon abandonment through nonuse to add the ground of fraud when it was learned in discovery, including a discovery deposition, that the registrant had never sold the relevant product under the mark in question and that fraud had allegedly occurred in the application process.

Here, the requested amendment is timely. Facts supporting the fraud ground were only recently learned at the late August depositions, Mrs. Taylor said she wanted to review and possibly make changes to her deposition, and the time period for the Taylors to make changes to their testimony only just elapsed on October 3, 2016. These facts concerning the Taylors' false statements were not previously known to Applicant. Further, the discovery period had not expired. In this respect, this motion is even more timely than the motion made (and granted) after discovery had closed in the *SaddleSprings* case. And, the proposed amendment here is in the nature of conforming to the evidence the grounds for the claim of cancellation.

There is no prejudice to Opposer from the proposed amendment. Opposer participated, via counsel, in the depositions, and asked questions during the depositions. Opposer is also in privity with the prior owner of the registration, having been the direct assignee of the Registration. There is also no prejudice as the amendment is in the nature of conforming the claim to the evidence. Further, the discovery period is not currently set to close until November 15, 2016 – over a month from now.

The amendment would not be futile. As set forth in the proposed amendment, the deposition testimony establishes the non-use, knowledge, falsity of the statements, and intention to deceive in order to obtain the trademark registration. Further, the decision in *SaddleSprings*,

Inc. v. Mad Croc Brands, Inc., No. 92055493 (TTAB Mar. 31, 2014), illustrates that if fraud may possibly be established, whether or not the trial testimony might later confirm or refute what is stated in the claim, then the proposed amendment is not futile and should be allowed on a motion to amend.

The proposed amendment is not asserted for purposes of delay or in bad faith. The information allowing for this ground of fraud was only recently learned. Applicant has been diligent in pursuing this case, having timely served initial disclosures and sent discovery requests early in the discovery period, and then taken the depositions of the Taylors within the discovery period. The discovery period is not set to close until November 15, 2016.

Opposer was contacted about this motion by phone on October 3, 2016 and again by email on October 5, 2016. Although Opposer's counsel has acknowledged the request, Opposer has not yet provided its position.

Applicant's motion should therefore be granted.

WHEREFORE, Applicant requests that its motion be granted and that its Amended Counterclaim be filed and treated as the currently operative counterclaim from Applicant.

Respectfully submitted this the 10th day of October, 2016.

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CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing Applicant's Motion for Leave to Amend Counterclaim, and Brief, with exhibits, has been served on Opposer (via its counsel) by mailing said copy on October 10, 2016 via e-mail and First Class Mail, postage prepaid, and addressed as follows:

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EXHIBIT 1

Applicant's Amended Counterclaim/Petition for Cancellation

)	
SIMPLY SOUTHERN FINE ARTS)	
AND HOME DÉCOR, LLC,)	Opposition No. 91224533
Opposer/Registrant,)	Application Serial No. 86/450,713
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v.)	Counterclaim Cancellation Petition
)	Registration No. 3,335,887
DAZZLE UP, LLC,)	
Applicant/Counterclaim)	
Petitioner.)	
)	

Dazzle Up, LLC (“Applicant”), by and through undersigned counsel, and pursuant to 37 C.F.R. § 2.107 and TBMP §§ 313 & 315, hereby provides its amended counterclaim/petition for cancellation as follows.

The grounds for this cancellation counterclaim are as follows:

1. Dazzle Up is a limited liability company organized and existing under the laws of the State of North Carolina, with a principal place of business located at 4300 Waterleaf Ct., Greensboro, North Carolina 27410.

2. Dazzle Up is the applicant for application Serial No. 86/450,713 which has been opposed by Simply Southern Fine Arts and Home Décor, LLC which has now filed an amendment reciting that its name is Simply Southern Fine Art and Home Décor, LLC (“Opposer”) on the basis, in part, of the Registration.

3. Opposer has alleged in its First Amended Notice of Opposition that it is a limited liability company formed under the laws of the State of Louisiana. Upon information and belief, Opposer mis-identified itself.

4. Opposer claims ownership of the Registration in its First Amended Notice of Opposition. Opposer cites the Registration as a basis, in part, for its opposition to Dazzle Up’s application Serial No. 86/450,713.

5. Upon information and belief, Simply Southern Fine Art and Home Décor, LLC (“SSFAHD”) is a limited liability company organized and existing under the laws of the State of Louisiana.

6. SSFAHD is the last listed owner of record for the Registration shown on the on-line TSDR records of the United States Patent and Trademark Office.

7. As shown on the on-line records of the United States Patent and Trademark Office, SSFAHD was purportedly assigned the Registration on May 19, 2015.

8. Opposer requested an extension of time to file its Notice of Opposition on May 26, 2015.

9. The Registration - No. 3,335,887 - is for the mark SIMPLY SOUTHERN for “Retail and computerized online ordering services featuring home furnishings, wall accessories, candles, tableware, housewares, glasswares, floral wreaths, wall shelves, benches, chairs, upholstered furnishings, clocks, wall artwork, primitive notecards, stationery, primitive dolls, wood figurines, pottery, baskets, pillows, rugs, dried florals,” in international class 035.

10. As reflected by the on-line records of the United States Patent and Trademark Office, the most recent prior owner of the Registration was Lawrence Taylor (“Taylor”), an individual who provided an address in Melbourne, Florida.

Abandonment

11. Upon information and belief, Taylor, or another prior owner of the Registration, ceased using with no intention to resume use of, and otherwise abandoned, the use of SIMPLY SOUTHERN for all, or some, of “Retail and computerized online ordering services featuring home furnishings, wall accessories, candles, tableware, housewares, glasswares, floral wreaths, wall shelves, benches, chairs, upholstered furnishings, clocks, wall artwork, primitive notecards, stationery, primitive dolls, wood figurines, pottery, baskets, pillows, rugs, dried florals.”

12. Upon information and belief, Taylor, or another prior owner of the Registration, failed to use SIMPLY SOUTHERN for all, or some, of “Retail and computerized online ordering services featuring home furnishings, wall accessories, candles, tableware, housewares, glasswares, floral wreaths, wall shelves, benches, chairs, upholstered furnishings, clocks, wall artwork, primitive notecards, stationery, primitive dolls, wood figurines, pottery, baskets, pillows, rugs, dried florals,” for at least three consecutive years.

13. The Registration was abandoned, in part or in whole, within the meaning of 15 U.S.C. § 1064(3) & 1127.

14. The Registration should therefore be cancelled, in part or in whole, due to abandonment.

15. Dazzle Up has been damaged and will continue to be damaged if the Registration is permitted to remain on the Principal Register, including because the Registration has been cited by Opposer as a basis for its opposition to Dazzle Up's application Serial No. 86/450,713.

Fraud

16. Dazzle Up incorporates by reference and re-alleges herein paragraphs 1 through 15.

17. The application which became the Registration was filed on February 23, 2004 by Catherine Kolczynski, for a company representing itself in its application as Simply Southern, LLC, organized under the laws of the United States.

18. Mrs. Kolczynski's deposition testimony confirmed that the applicant company was actually a Florida company and that the company was cancelled and not renewed sometime between 2005 and 2007. (C. Taylor Dep. pp. 11:1-15:20.) A copy of excerpts of the sworn deposition of Catherine Taylor f/k/a Catherine Kolczynski is attached as Exhibit A and referred to herein as "C. Taylor Dep."

19. According to the assignment recorded at Reel/Frame 3219/0867 of the United States Patent and Trademark Office, the trademark application was assigned to Lawrence Taylor, an individual, on December 31, 2005.

20. Mr. Taylor testified that he never provided any services under the SIMPLY SOUTHERN mark. (L. Taylor Dep. p. 10:6-10 ["Q: ... were you the one that provided the services under the Simply Southern mark? A: No, sir, I was not."].) Nor was he aware of any sales made in connection with the Simply Southern business. (L. Taylor Dep. p. 16:22-25 [Q: Mr. Taylor, were sales made in connection with the Simply Southern business? A: Like I say again, I'm not

aware. This operation is handled by Catherine, completely.”].) A copy of excerpts of the sworn deposition of Lawrence Taylor is attached as Exhibit B and referred to herein as “L. Taylor Depo.”

21. Mr. and Mrs. Taylor testified that Mr. Taylor let Catherine Kolczynski, who later became his wife Catherine Taylor, run the Simply Southern business, completely handle the trademark application and even sign his name for him on trademark filings. (L. Taylor Dep. pp. 11:16-12:9, 16:22-25, 19:20-20:2, 20:16-21:3 & 23:4-21; C. Taylor Dep. pp. 46:17-47:5.) For substantial periods of time, Mr. Taylor was not in the country. Although not in the military at the time, he was, in his own words, an “aerospace tech engineer” from 2004 to 2010, often in Afghanistan. (L. Taylor Dep. p. 24:17-24.)

22. Mrs. Catherine Taylor testified that she actually operated the enterprise they called Simply Southern in the 2000s and that it was in Mr. Taylor’s name because, as such, it could be characterized as a veteran-owned, minority-owned business. (C. Taylor Dep. pp. 8:3-12 & 23-25.) He was a “silent partner” for the business, in both of their words, both before they were married and then afterwards. (C. Taylor Dep. pp. 8:13-9:3; L. Taylor Dep. p. 9:17-20).

23. On June 21, 2007, a Statement of Use with Mr. Taylor’s e-signature was filed asserting that he, or his related company or licensee, was using the mark SIMPLY SOUTHERN in commerce on or in connection with all services listed in the application or Notice of Allowance, namely with “retail and computerized online ordering services featuring home furnishings, wall accessories, candles, tableware, housewares, glasswares, floral wreaths, wall shelves, benches, chairs, upholstered furnishings, clocks, wall artwork, primitive notecards, stationery, primitive dolls, wood figurines, pottery, baskets, pillows, rugs, dried florals.”

24. The Statement of Use included a “brochure” as a specimen and asserted that the specimen showed the mark as used in commerce and that the brochure was actually used.

25. The Statement of Use was filed under penalty of perjury.

26. The Statement of Use was false and fraudulent, as demonstrated by the Taylors' deposition testimony.

27. Its falsity had several aspects, including the following.

28. First, the brochure filed as a specimen was not actually in use, contrary to the sworn representation. Mrs. Taylor testified: "A: I would have done the printing, but I had not distributed the brochures. Q: So I'm clear, did you ever distribute the brochures? A: I didn't." (C. Taylor Depo. p. 45:12-19.) Mrs. Taylor testified that while she had plans to lay out the brochures on tables at some retail space she might get or craft fair space, she never did. (*Id.*)

29. The representations in the Statement of use that the specimen was actually used and that it showed the mark used in commerce were false and fraudulent.

30. Second, the mark was not otherwise in use with the identified services as the identified services were not being rendered by any of the Taylors, any related company, their enterprise or any licensee.

31. The services were identified in the application as "retail and computerized online ordering services featuring [a variety of products]."

32. Mrs. Taylor's testimony was that they never rendered the ordering services, whether of the retail variety or the computerized online variety.

33. Mrs. Taylor testified that her enterprise never had a website through which orders could be made online. She testified:

Q: Did you ever operate a computerized on-line ordering service?

A: I had worked on getting the website up and running for the computerized service, and I was having just issues with back-end problems. So, I didn't – I wasn't able to sell things on-line.

Q: Were you ever able to sell things on-line?

A: No. I was gearing up to try and get the website back up and running. . . . I did have the website up but you couldn't order from it.

...

A: ... I think the website was on the Internet, but you couldn't order from it because the back end wasn't working. So, operational, no. It was physically out in the Internet, but it wasn't operational.

(C. Taylor Depo. pp. 16:17-17:6 & 29:9-15)

34. Although her enterprise had a static website advertising products, orders never could be placed and never could be taken through the website. Therefore, no online ordering service could be rendered, and no online service was ever sold.

35. Mrs. Taylor even testified in response to questioning by Opposer's counsel that her website failed to list a phone number for consumers to call to place orders. She testified: "Q: And if someone would have gone to your website, even though it was not perhaps a fully functional e-commerce site, would such a prospective customer [have] been able to call you and say, I like this item I would like to buy it from you? A: I'm not sure I listed the phone number." (C. Taylor Depo. p. 55:20-25).

36. Further, Mrs. Taylor testified that no one ever called or contacted them to place an order due to the website. She testified: "Q: [Mrs.] Taylor, Mr. Delaune asked you about your website during the time period 2004 to 2010 and whether there was contact information, whether

or not someone could have called and placed an order. Let me ask you: Did anybody ever call or otherwise contact you because of the website and place an order? A: No.” (C. Taylor Dep. p. 57:11-18.)

37. Mrs. Taylor additionally testified that their enterprise never operated a retail store, nor a retail store under the name SIMPLY SOUTHERN.

38. In response to the question “Did you ever operate a retail store,” she answered “I did not operate a retail store” (C. Taylor Depo. p. 16:11-16.)

39. Mrs. Taylor testified that she signed a lease for a space one time in Charlotte, North Carolina, but she “was never able to go in and put products into what kiosk because we were moving.” (C. Taylor Depo. p. 16:11-16.)

40. The enterprise therefore never provided the identified services of providing “retail and computerized online ordering services ...”

41. The phrase “retail and computerized online ordering services ...” refers to the provision of online ordering services, both retail and computerized, much like that provided by Amazon or eBay.

42. Mr. Taylor, the Taylors and their enterprise never rendered such a service.

43. Mrs. Taylor testified that they neither licensed nor authorized anyone else to use SIMPLY SOUTHERN. (C. Taylor Dep. p. 37:20-25.)

44. Mrs. Taylor was also asked by counsel for Opposer whether the brochure filed as the specimen accurately reflected the services purportedly offered by the Taylors, and Mrs. Taylor answered that she was just selling some of the items, and that she “wasn’t really providing a service.” She instead sold “barn stars” and “wreaths.” (C. Taylor Dep. pp. 53:21-54:6.)

45. In contrast to the identified services that were never rendered, Mrs. Taylor testified that she sold a few products on eBay under either the SIMPLY SOUTHERN or SIMPLY SOUTHERN HOME names. She explained that she would, on occasion, purchase products and then post them for re-sale on eBay. (C. Taylor Dep. p. 20:13-14 [“I would order certain products that I liked, and then I would go to sell them on eBay.”].) However, selling on eBay is not the provision of “retail and computerized online ordering services.”

46. A seller utilizing eBay’s online marketplace to sell products she has already obtained is not herself rendering an online ordering service, rather the seller is utilizing eBay’s online service.

47. The use of a putative mark for products sold through eBay in the way described by Mrs. Taylor is only, at most for the seller, the use of a mark for the goods being sold. It is not the use of the mark to identify any service. Indeed, in that instance, eBay – not the product seller – is the only entity actually providing the retail, online service that operates the website, displays the products for sale at the request of a seller, allows a buyer to signal a desire to purchase, and then processes the order including funds transfer.

48. Further, the Taylors’ sales via eBay were, in Mrs. Taylor’s words, “minimal” and “only a few hundred dollars a year” “from 2004 maybe up to 2010,” with no eBay sales after the 2010/2011 time frame except for personal items, such as “clothing” and “kid’s shoes.” (C. Taylor Dep. pp. 18:25-19:18 & pp. 22:2-23:2.) This level of sales is token, sporadic and not substantially continuous, and not sufficient to establish use in commerce for a Statement of Use or Allegation of Use.

49. The SIMPLY SOUTHERN name was not used as a mark for the services identified in the application by Mr. Taylor or his related company or licensee, and thus the representations to the contrary in the Statement of Use was false.

50. Third, the identification of services subject to the Statement of Use included a listing of “featured” products that were never sold nor featured. The averment in the Statement of Use that the services featured such products was false and fraudulent.

51. The identification of services specifically stated that the services featured “home furnishings, wall accessories, candles, tableware, housewares, glasswares, floral wreaths, wall shelves, benches, chairs, upholstered furnishings, clocks, wall artwork, primitive notecards, stationery, primitive dolls, wood figurines, pottery, baskets, pillows, rugs, dried florals.”

52. Mrs. Taylor, however, testified that the only items sold, even under her “minimal” sales on eBay, were “primitive items” consisting of barn stars, country-style curtains and wreaths.

53. The 2007 Statement of Use was false and fraudulent in its statement that the services featured “candles, tableware, housewares, glasswares, wall shelves, benches, chairs, upholstered furnishings, clocks, notecards, stationery, dolls, figurines, pottery, baskets, pillows, rugs [and] dried florals.” Not only were no such services being provided, but such items were also not being provided or “featured” in the services. That representation otherwise was false.

54. Mrs. Taylor testified that much later, in between 2011 and 2013, she sold one clock, one bench, notepads and two wreaths at a neighborhood yard sale. These sales, of course, had not occurred when the 2007 Statement of Use was filed, also were not online, were not the provision of an ordering service, were not through a retail establishment, were not the rendering of a retail service, were “sporadic,” and were mere token sales, in sufficient to show use of a service mark in commerce.

55. The Statement of Use was therefore false and fraudulent.

56. The Statement of Use included the specific false representations identified above.

57. The false representations were material to the registrability of the mark. Without the representations, the United States Patent and Trademark Office could not have validly granted the registration.

58. Mr. Taylor and/or his wife, who e-signed his name for him, knew of the falsity of the representations.

59. Mr. Taylor and/or his wife, who e-signed his name for him, made the false representations with the intention to deceive the United States Patent and Trademark Office and obtain a registration when one should not have been issued for the identified services.

60. On December 4, 2012, Mrs. Taylor filed a Combined Declaration of Use and Incontestability with Mr. Taylor's e-signature asserting that the mark SIMPLY SOUTHERN was in use in commerce on or in connection with all services listed in the registration, namely with "retail and computerized online ordering services featuring home furnishings, wall accessories, candles, tableware, housewares, glasswares, floral wreaths, wall shelves, benches, chairs, upholstered furnishings, clocks, wall artwork, primitive notecards, stationery, primitive dolls, wood figurines, pottery, baskets, pillows, rugs, dried florals." The filing further asserted that the mark had been continuously used in commerce for five (5) consecutive years after the date of registration and was still in use in commerce on or in connection with all services. The filing was made under penalty of perjury.

61. This filing was false and fraudulent in a number of respects.

62. First, as described above, the mark was never in use with the identified services as the identified services were never rendered by any of the Taylors, any related company, their enterprise or any licensee.

63. Not only was it the case that the Taylors never rendered the identified services, but by 2012, even the eBay sales were not occurring. As Mrs. Taylor testified, they had no eBay sales after the 2010/2011 time frame except for personal items, such as “clothing” and “kid’s shoes.” (C. Taylor Dep. p. 18:25-19:18 & p. 22:2-23:2.) Such personal items are not within the identification of services in the Registration.

64. With respect to the sales between 2011 and 2013 of one clock, one bench, notepads and two wreaths at a neighborhood yard sale, those sales were not the provision of the services identified in the Registration. They were not the rendering of an ordering service, were not through a retail establishment, were not the rendering of a retail service, and were merely “sporadic” and token sales, insufficient to show use of a service mark in commerce, much less substantially continuous use in commerce.

65. Second, as with the Statement of Use, the identification of services subject to the Combined Declaration of Use and Incontestability included a listing of “featured” products that were never sold nor featured. The averment in the Combined Declaration of Use and Incontestability that the services featured such products was false and fraudulent.

66. The 2012 Combined Declaration of Use and Incontestability was false and fraudulent in its statement that the services featured “candles, tableware, housewares, glasswares, wall shelves, chairs, upholstered furnishings, stationery, primitive dolls, wood figurines, pottery, pillows, rugs, [and] dried florals.” Not only were no such services being provided, but such items were also neither provided nor featured in the services. The representation otherwise was false.

67. Third, the 2012 Combined Declaration of Use and Incontestability was false and fraudulent in that it asserted that the mark had been continuously used in commerce for five (5) consecutive years after the date of registration on or in connection with all services, when in fact that assertion was false.

68. The Combined Declaration of Use and Incontestability included the specific false representations identified above.

69. The false representations in the Combined Declaration of Use and Incontestability were material to the continued registration of the mark. Without the representations, the United States Patent and Trademark Office would have cancelled the Registration and could not have accepted the Declaration of Incontestability.

70. Mr. Taylor and/or his wife, who e-signed his name for him, knew of the falsity of the representations.

71. Mr. Taylor and/or his wife, who e-signed his name for him, made the false representations with the intention to deceive the United States Patent and Trademark Office, avoid cancellation of the registration, and gain acceptance of the Declaration of Incontestability, when the Registration should have been cancelled.

72. The Registration should therefore be cancelled, in part or in whole, due to abandonment and any one or more of the instances of fraud.

73. Dazzle Up has been damaged and will continue to be damaged if the Registration is permitted to remain on the Principal Register, including because the Registration has been cited by Opposer as a basis for its opposition to Dazzle Up's application Serial No. 86/450,713.

WHEREFORE, Petitioner respectfully requests that this counterclaim/petition be sustained and that Registration No. 3,335,887 be cancelled.

Respectfully submitted this the 10th day of October, 2016.

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CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing Applicant's Amended Counterclaim/Petition for Cancellation has been served on Opposer (via its counsel) by mailing said copy on October 10, 2016 via e-mail and First Class Mail, postage prepaid, and addressed as follows:

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SIMPLY SOUTHERN FINE ARTS
AND HOME DECOR, LLC,

Opposer/Registrant,

v.

DAZZLE UP, LLC,

Applicant/Counterclaim
Petitioner.

DEPOSITION OF CATHERINE TAYLOR

Taken on Behalf of the Applicant/
Counterclaim Petitioner

August 23, 2016

9:35 a.m. - 11:05 a.m.

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(Reporter's Note: Exhibits 1 through 4 were marked
for identification in the deposition of Lawrence
Taylor taken on August 23, 2016.)

1 WHEREUPON,

2 CATHERINE TAYLOR,

3 acknowledged having been duly sworn to tell the

4 truth and testified upon her oath as follows:

5 THE WITNESS: Yes.

6 DIRECT EXAMINATION

7 BY MR. SAR:

8 Q Would you please state your name for the
9 record?

10 A Catherine Ann Taylor.

11 Q And have you ever gone by any prior names,
12 like a maiden name?

13 A I was married prior. That last name was
14 Kolczynski, and my maiden name was Kovach.

15 Q Could you spell those for the court
16 reporter?

17 A Kolczynski is K-O-L-C-Z-Y-N-S-K-I; Kovach,
18 K-O-V, as in Victor, A-C-H.

19 Q Miss Taylor -- Mrs. Taylor, my name is
20 David Sar. I'm an attorney at the law firm of
21 Brooks, Pierce, McLendon, Humphrey & Leonard. I
22 live in Greensboro North Carolina, which is where my
23 law firm is located. In this matter, I represent
24 Dazzle Up, LLC.

1 A It's the official registration of the
2 trademark that I have filed back any, I think, '04.

3 Q And how did it come to be that you filed
4 for this trademark in '04 when it listed Lawrence
5 Taylor as the owner of the trademark?

6 A I originally filed it, and I don't
7 remember if it was in my name or both of our names;
8 and then I had it transferred to him. It is more of
9 an opportunity as a veteran-owned, minority-owned
10 business. And I probably could have done that more
11 on the corporate side but that was my thought back
12 then.

13 Q Gotcha. And who was the -- was anyone
14 else involved in this business besides you and your
15 husband?

16 A No. It was really just me. He didn't do
17 too much. He was a silent partner.

18 Q At the time he was not yet your husband;
19 is that correct?

20 A That's correct.

21 Q When did you all get married?

22 A In 2010.

23 Q Was he both a veteran-owned and minority-
24 owned component of the business?

25 A Yes.

1 Q Who actually operated the business, you or
2 he?

3 A I did.

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1 Q Sure. Did you set up any company for
2 Simply Southern?

3 A I set up an LLC through the state of
4 Florida. But it was Simply Southern, and I don't
5 recall what year I did that.

6 Q Is it still an operational LLC?

7 A No.

8 Q When did it stop being operational?

9 A I don't remember that date. It might have
10 been included in the documents I sent you. I would
11 have to refer back to that.

12 MR. SAR: Let's have marked as the next
13 exhibit, Exhibit 5.

14 Warner, is it okay with you to have
15 continuous numbering?

16 MR. DELAUNE: I'm sorry. I was on mute.
17 That's fine, David.

18 (Exhibit No. 5 was marked for
19 identification.)

20 BY MR. SAR:

21 Q So Miss Taylor, I'm going to pass you
22 what's just been marked as Exhibit 5. It's a
23 stapled set of papers, which I believe is the
24 scanned -- or it's a printout of scanned email you
25 sent to me. Do you know what Exhibit 5 is?

1 A Yes.

2 Q Take a look at it and see if you can
3 independently assess what it is and please tell me
4 what it is?

5 A The entire document or?

6 Q Does this look like a printout of
7 everything you sent me by email in response to this
8 subpoena?

9 A Yes, it looks like everything.

10 Q Does looking at any of these pages refresh
11 your memory such that you can answer my question
12 about whether the LLC is currently an operational
13 LLC?

14 A No, it's not in here.

15 (Perusing document.) Oh, yes, it is.

16 This was the -- I don't know if this was
17 an original document. It was a 2005 annual report
18 that I had filed. That was with the state of
19 Florida. I don't see the date when that was
20 cancelled.

21 Q So just for the record, I believe you are
22 looking at the next to the last page of Exhibit 5,
23 it's a page which starts off "2005 Limited Liability
24 Company Annual Report"; is that correct?

25 A Yes.

1 Q So Miss Taylor, is it your belief that the
2 LLC was cancelled at some point by the Florida
3 Secretary of State?

4 A I probably did not renew because at the
5 time we had lived in Charlotte, North Carolina.

6 Q Do you remember if it wasn't renewed back
7 in the 2000s?

8 A It probably wasn't renewed. I would be
9 guessing.

10 If this was '05, it could have been '06.

11 Q Do you think it probably was 2005, 2006,
12 2007, that it was not renewed?

13 A It could have been, yes.

14 Q Do you recall paying any annual fees to
15 the State of Florida in connection with keeping up
16 the company in 2006 or 2007?

17 A I know if I renewed, I would have paid a
18 fee, but if it wasn't renewed, I didn't pay the fee.
19 Originally, I paid an original fee. So I don't know
20 the exact date. I could have gone another year with
21 it. I don't know. This is something I would have
22 to look up and look on line.

23 Q Do you think at most you would have kept
24 it in place and renewed for a year or two after
25 2005?

1 A It's possible.

2 Q So then by 2007, it would not have been
3 renewed; is that correct?

4 A It's possible.

5 Q Is that a yes or a no?

6 A I don't know because that would be
7 guessing.

8 Q When did you -- did you move to North
9 Carolina after being -- after this time in 2005?

10 A I might have been there in 2004 or 2005.
11 I don't remember the exact dates that we were in
12 Charlotte.

13 Q Can you tell me the sequence of where you
14 lived with respect to Florida and North Carolina?

15 A I have been in Florida since I was a year
16 old and we moved to Charlotte, it was either 2004 or
17 2005. I want to say 2004, but I'm not positive. We
18 were there from June, possibly, of one of those
19 years to November; and then my husband's job took
20 him to Charleston, South Carolina, where we were
21 there until 2006, possibly September 2006, and then
22 we came back to Florida.

23 Q When you moved to North Carolina, is that
24 when you discontinued having in place the LLC from
25 Florida?

1 A Possibly not. I mean, if I moved to
2 Charlotte in 2004 and I still had this in 2005, it's
3 possible that the renewal came up in 2006 at the
4 beginning and I wasn't anticipating coming back, so
5 I didn't renew it. I'm not sure. I would have to
6 look at the date that it didn't renew, and I just
7 don't remember.

8 Q Okay. Is it your testimony, Miss Taylor,
9 that at some point in connection with your move to
10 North Carolina and the move to South Carolina that
11 at some point the LLC was no longer renewed?

12 A Yes.

13 Q And the moves to North Carolina occurred
14 in the 2004/2005 time period and then to South
15 Carolina in 2006; is that correct?

16 A Yes.

17 Q So then the LLC would not have been
18 renewed in approximately 2004, 2005 or 2006; is that
19 correct?

20 A Possibly.

11 Q Did you ever operate a retail store?

12 A I did not operate a retail store but I had
13 signed a lease with a company called Blackline at
14 one time in Charlotte, North Carolina. And I never
15 was able to go in and put products into what kiosk
16 because we were moving.

17 Q Did you ever operate a computerized
18 on-line ordering service?

19 A I had worked on getting the website up and
20 running for the computerized service, and I was
21 having just issues with back-end problems. So, I
22 didn't -- I wasn't able to sell things on-line.

23 Q Were you ever able to sell things on-line?

24 A No. I was gearing up to try and get the
25 website back up and running. I had even had to hire

1 somebody to hire the back end. I can do a lot of
2 front end stuff and design. I'm not a programmer.
3 So I was having a lot of problems with that, and I
4 would have had to put some money into getting the
5 back end going. I did have the website up but you
6 couldn't order from it.

25

Q So with respect to the products that you

1 sold on eBay, what was the volume sales that you
2 had?

3 A Oh, it was minimal.

4 Q Like what does "minimal" mean?

5 A I didn't order in great quantities because
6 I didn't have the space, and I didn't have the
7 rental space. So, I would say -- I couldn't even
8 guess.

9 Do you want a dollar figure of
10 something -- of a group of things I would order? I
11 need clarification on the volume.

12 Q Sure. So in a given year, how much would
13 your total sales have been for the eBay on-line
14 sales under Simply Southern or Simply Southern Home?

15 A I would say back in 2004 is when I really
16 had started selling a lot of things on eBay. So
17 from 2004 maybe up to 2010 it was only a few hundred
18 dollars a year.

8 Did someone place the order to you and
9 then you would purchase the product they had
10 ordered; or, would you order the product and have it
11 in inventory hoping that someone would then buy it
12 from you?

13 A I would order certain products that I
14 liked, and then I would go to sell them on eBay.

2 Q What about after 2010? What were your
3 sales through eBay under Simply Southern or Simply
4 Southern Home?

5 A I probably didn't do a lot with eBay in
6 2010, and that was just because my husband had gone
7 off to Afghanistan and I was trying to get my
8 family -- it was just me and my daughter, and I
9 homeschool her, as well. So some things started to
10 get in the way at that time.

11 Q So then by 2010, at some point during the
12 year, you stopped selling on eBay; is that correct?

13 A I would have to -- you can probably
14 subpoena records from eBay. I don't know the exact
15 dates, but 2010/2011 time frame.

16 Q So then by 2011, by the end of 2011, you
17 had stopped -- is it correct to say you had stopped
18 selling on eBay under Simply Southern?

19 A I stopped selling probably the primitive
20 type items, but then I had commingled some personal
21 items in there that were still under the Simply
22 Southern name, but they wouldn't have been for the
23 company.

24 Q What sorts of personal items were you
25 selling?

1 A Clothing, kid's shoes, whatever was around
2 the house, possibly.

3 Q If you look at the Trademark Registration
4 Certificate you have in front of you, Exhibit 1,
5 were there any items listed in that description of
6 services that you sold after 2011?

7 A If I had some items that I had ordered
8 from a company. I had a clock. I had ordered a
9 couple of wooden-style primitive trash buckets and
10 laundry baskets. I had a deacon's bench that I had
11 ordered. And those would have been after because I
12 wouldn't have sold those on eBay; they were too big
13 items to do that with. And I sold them during
14 neighborhood sales that I had. And I did that
15 probably up through, I'm guessing, 2013.

16 Q When you sold those items, the clock,
17 primitive items, the deacon's bench, and when you
18 sold them through neighborhood sales, did you use
19 the Simply Southern name in connection with those
20 neighborhood sales?

21 A I had my tag on them.

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3 Q I see. In the middle of the second
4 paragraph, do you see the sentence, which starts
5 "moreover," where it says, "Moreover, we have
6 researched your use of that name and it appears to
7 us to be abandoned"; do you see that?

8 A Yes, I see that.

9 Q At the point in time of this letter in
10 2015, was it true that you did not have a website?

11 A No, I think the website was on the
12 Internet, but you couldn't order from it because the
13 back end wasn't working. So operational, no. It
14 was physically out in the Internet, but it wasn't
15 operational.

5 Q When you say the neighborhood sales that
6 you did, that you have already testified about, what
7 city were you in at the time?

8 A Viera, Melbourne.

9 Q Melbourne, Florida?

10 A Melbourne, Florida, yes.

11 Q Were you aware of anyone confusing your
12 Simply Southern with jewelry or costume jewelry
13 brand?

14 A No.

15 Q Were aware of anyone ever confusing your
16 use of Simply Southern with any other use of Simply
17 Southern by someone else?

18 A I'm not aware of someone having confusion
19 like that.

20 Q Did you ever license anyone else to use
21 Simply Southern?

22 A No.

23 Q Did you ever authorize anyone else to use
24 of Simply Southern?

25 A No.

1 BY MR. SAR:

2 Q Miss Taylor, I'm passing you Exhibit 10;
3 do you know what Exhibit 10 is?

4 A It indicates that it's a Trademark,
5 Service Mark Statement of Use. And this could have
6 been in response to the Notice of Abandonment.

7 Q It look like it may have been e-signed by
8 Lawrence Taylor in 2007; do you know if that is
9 accurate or did you handle this filing?

10 A I would have handled that filing.

11 Q So you even though it says it looks like
12 it's his typed name in between slashes, you actually
13 would have typed that in?

14 A I did.

15 Q Would you look at the last page of Exhibit
16 10?

17 A (Complies.) Yes.

18 Q What is this last page?

19 A It was a brochure that I had been working
20 on for items that I was going to sell. There was a
21 way that it folded.

22 Q That was going to be my question. Is this
23 one of those, like, tripartite, three-folded
24 brochures, front and back?

25 A Yes.

1 Q Okay. Is this an actual copy of one of
2 the actual brochures or was this something on a
3 computer file that would have been used for a
4 brochure?

5 A Well, I created it using a computer file
6 and then I printed some and had them; but this was
7 going to be more when I was looking for rental space
8 and be able to hand out my brochures. So, it was
9 more to be printed and used as a tri-fold.

10 Q Did you ever end up having it printed and
11 distributing these brochures?

12 A I would have done the printing, but I had
13 not distributed the brochures. My thought process
14 was trying to get to some retail space or craft fair
15 space to where I would have those brochures laid out
16 on the table.

17 Q So I'm clear, did you ever distribute the
18 brochures?

19 A I didn't.

20 Q This last page lists the address as
21 Co-Coa, Florida?

22 A Cocoa.

23 Q Cocoa, Florida.

24 Is that where you were living at the time?

25 A Yes, that's the address we moved into when

1 we came back from South Carolina.

2 Q Is the address listed as a home address or
3 is it some other?

4 A That's a home address.

5 Q It says, "Coming soon, www.simplysouthern
6 home.com."

7 Was www.simplysouthernhome.com operational
8 at the time of this brochure's filing in 2007?

9 A No. Otherwise, it couldn't say, "coming
10 soon."

16 BY MR. SAR:

17 Q Miss Taylor, I'm passing you Exhibit 11.
18 Do you know what Exhibit 11 is?

19 A It says, "Combined Declaration of Use
20 Incontestability." I don't know what this is.

21 Q On Page 3, it looks like it has an
22 e-signature for Lawrence Taylor?

23 A Yes.

24 Q Do you think he filed this or did you file
25 this for him?

1 A I filed it.

2 Q And do you recall filing this in December
3 of 2012 for him?

4 A That's what it shows that it was signed.
5 So, I don't recall doing it, but I obviously did it.

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13 Q And your website was not taking orders as
14 of this point in time, correct?

15 A 2012, no.

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1 Q Miss Taylor, earlier you mentioned clocks,
2 primitive items and a deacon's bench that were sold
3 through neighborhood sales.

4 Were those items that you had purchased or
5 obtained for the purpose of resale or had you just
6 obtained them personally and then chose to sell them
7 later?

8 A For the purpose of resale.

9 Q Okay.

10 A And there may have been many other items.
11 Those are the ones that I remember.

12 Q How many clocks were there?

13 A I ordered one clock.

14 Q There was one deacon's bench, as well.

15 A Yes. And those were from a company called
16 Cody Road.

17 Q How do you spell that?

18 A C-O-D-Y, R-O-A-D.

19 Q Was there some sort of neighborhood event
20 going on for which you thought you could sell it?

21 A The neighborhood just puts on sales. We
22 live in a neighborhood that you can only sell things
23 at certain times. You can't just arbitrarily have a
24 sale. It's a gated community. So they open the
25 gates during certain times, and there is a park that

1 people will go and sell things at. Some fundraisers
2 will be out there.

3 Q Okay. Are they regularly scheduled sales
4 like a spring flea market or something?

5 A Yes, they are usually twice a year.

6 Q Was that the neighborhood sale that you
7 were referencing earlier when you said you sold
8 items, the clock, the primitive items and deacon's
9 bench at the neighborhood sales?

10 A Yes.

11 Q Were they all through the same gated
12 community neighborhood sale?

13 A Yes.

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21 Q Right. Did that document accurately
22 reflect the services that you were offering under
23 the Simply Southern mark?
24 A Well, it accurately reflected some of the
25 items that I had sold under that name. I wasn't

20 Q And if someone would have gone to your
21 website, even though it was not perhaps a fully
22 functional e-commerce site, would such a prospective
23 customer been able to call you and say, I like this
24 item I would like to buy it from you?
25 A I'm not sure I listed the phone number.

REDIRECT EXAMINATION

BY MR. SAR:

Q Miss Taylor, Mr. DeLaune asked you about your website during the time period 2004 to 2010 and whether there was contact information, whether or not someone could have called and placed an order. Let me ask you: Did anybody ever call or otherwise contact you because of the website and place an order?

A No. And I do have to clarify that because 2004 to 2010, I'm not sure the website was up. I think I did that later.

Q Okay.

A And I don't know the exact date that it was on the Internet. I think in 2008 I had it designed but I'm not sure it was -- there wasn't any back end to that. And at some point in time, I had

1 to have someone else come in and redo it to put it
2 on some sort of e-commerce site and that is where
3 the back end didn't work at all. But that might
4 have been after 2010.

5 MR. SAR: I have nothing else.

6 MR. DELAUNE: Nothing else for me.

7 MR. SAR: Thank you very much, Miss
8 Taylor. We're done.

9 THE COURT REPORTER: Are we ordering the
10 transcripts?

11 MR. SAR: Yes, I want to get a copy of
12 both depositions.

13 Miss Taylor, do you to get a copy and to
14 review it and have a chance to make any
15 corrections that you feel are appropriate and
16 to sign off that it was accurately recorded?

17 THE WITNESS: Yes.

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CERTIFICATE OF OATH

STATE OF FLORIDA)
COUNTY OF BREVARD)

I, Alexa C. Brickweg, Florida Professional
Reporter, Notary Public State of Florida,
certify that CATHERINE TAYLOR personally
appeared before me on this 23rd day of August
2016 and was duly sworn.

Personally Known_____

Represented by Counsel_____

Produced I.D._____X_____

Alexa C. Brickweg, FPR
Notary Public and State of Florida at Large
Notary Certificate #CC 860189
(My Commission Expires: 8-7-19)

CERTIFICATE OF REPORTER

STATE OF FLORIDA)
COUNTY OF BREVARD)

I, Alexa C. Brickweg, Florida Professional
Reporter, do hereby certify that I was
authorized to and did stenographically report
the deposition of CATHERINE TAYLOR; that a
review of the transcript was requested; and
that the foregoing transcript, pages 1 through
59, is a true record of my stenographic notes.

I FURTHER CERTIFY that I am not a
relative, employee, or attorney, or counsel of
any of the parties, nor am I a relative or
employee of any of the parties' attorney or
counsel connected with the action, nor am I
financially interested in the action.

DATED this 31st day of August 2016.

A handwritten signature in black ink, reading "Alexa C. Brickweg", is written over a horizontal line.

Alexa C. Brickweg, FPR
Florida Professional Reporter

WITNESS NOTIFICATION LETTER

August 31, 2016

Catherine Taylor
6494 Trieda Drive
Melbourne, Florida 32940
taycat@me.com

Re: SIMPLY SOUTHERN FINE ARTS AND HOME DECOR,
LLC
U.S. Legal Support Job No.: 1456600

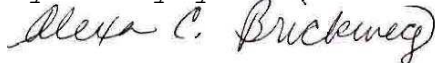
Dear Ms. Taylor,

The transcript of the above-referenced proceeding
has been prepared, and a courtesy copy is enclosed
here for your review.

Any corrections you wish to make to the transcript
should be made on the errata sheet. Please do not
write on the transcript itself.

Please complete review of your transcript within a
reasonable time and return the errata sheet to our
offices. You need not return the entire transcript;
a self-addressed envelope is enclosed for your
convenience.

Very truly yours,



Alexa C. Brickweg, FPR
Florida Professional Reporter
U.S. Legal Support, Inc.
20 North Orange Avenue
Suite 1209
Orlando, Florida 32801
407-649-9193

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD
Opposition No. 91224533
Application Serial No. 86/450,713

Counterclaim Cancellation Petition
Registration No. 3,335,887

SIMPLY SOUTHERN FINE ARTS
AND HOME DECOR, LLC,

Opposer/Registrant,

v.

DAZZLE UP, LLC,

Applicant/Counterclaim
Petitioner.

DEPOSITION OF LAWRENCE TAYLOR

Taken on Behalf of the Applicant
Counterclaim Petitioner

August 23, 2016

9:00 a.m. - 9:30 a.m.

GrayRobinson,
1795 W. NASA Blvd
Melbourne, FL 32901

Reported By:
Alexa C. Brickweg, FPR
Notary Public, State of Florida
U.S. Legal Support
20 North Orange Avenue
Suite 1209
Orlando, Florida 32801
Melbourne Office Job # 1456600

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(Reporter's Note: Exhibits 1 through 4 are
referenced in the deposition of Catherine Taylor
taken on August 23, 2016.)

1 WHEREUPON,

2 LAWRENCE TAYLOR,

3 acknowledged having been duly sworn to tell the

4 truth and testified upon his oath as follows:

5 THE WITNESS: So help me God.

6 DIRECT EXAMINATION

7 BY MR. SAR:

8 Q Mr. Taylor, my name is David Sar. I'm an
9 attorney for Brooks, Pierce, McLendon, Humphrey &
10 Leonard located in Greensboro, North Carolina. I
11 represent a company from North Carolina by the name
12 of Dazzle Up, LLC, and you are here for your
13 deposition.

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7 BY MR. SAR:

8 Q So Mr. Taylor, this Exhibit 1, the
9 Certificate of Registration, is this a copy of the
10 registration certificate for your words "Simply
11 Southern"?

12 A Yes, it is.

13 Q And this on the third page, it says
14 registration No. 3,335,887, doesn't it, in the upper
15 right?

16 A Yes, it does.

17 Q Mr. Taylor, this lists you personally as
18 the owner of this trademark registration; is that
19 correct?

20 A That's correct.

21 Q The registration certificate also lists
22 the services for which this trademark is registered;
23 is that correct?

24 A Yes, it does.

25 Q And those services are listed as, and I'm

1 going to read them here, but please tell me if I'm
2 getting this right. They are listed, aren't they,
3 retail and computerized on-line ordering services,
4 featuring home furnishings, wall accessories,
5 candles, tableware, housewares, glasswares, floral
6 wreaths, wall shelves, benches, chairs, upholstered
7 furnishings, clocks, wall artwork, primitive
8 notecards, stationary, primitive dolls, wood
9 figurines, pottery, baskets, pillows, rugs and dried
10 florals; is that what it says?

11 A That is correct.

12 Q So Mr. Taylor, those are all ordering
13 services; is that correct?

14 A Yes, sir.

15 Q What's an ordering service?

16 A That's where there is no actual brick and
17 mortar storefront. From my understanding, because I
18 was just a silent partner in this with my wife, she
19 was just using other on-line services to affect
20 sales through her website.

21 Q So then does the retail and computerized
22 on-line ordering services mean that she had a
23 website, she obtained the products from other people
24 and when an order came in, she obtained the product
25 and then sold it to whoever had ordered it on line?

16 Q So, did you give Catherine permission to
17 use the Simply Southern name in connection with this
18 business?

19 A Yes, I did.

20 Q Was it a verbal permission or written?

21 A I can't honestly say. It is just, "Here,
22 sign this. I'm putting a trademark in your name."

23 Q Okay. And so, for the trademark
24 application filings, did she handling the filings?

25 A Yes, she did.

22 Q Mr. Taylor, were sales made in connection
23 with the Simply Southern business?
24 A Like I say again, I'm not aware. This
25 operation is handled by Catherine, completely.

20 Q In the middle of that paragraph, do you
21 see the sentence where it states "moreover we have
22 researched the use of that name, and it appears to
23 us to be abandoned"?

24 A Yes.

25 Q Do you have any reason to agree or

1 disagree with that sentence?

2 A Like I say, this was Catherine's business.

3 Q Mr. Taylor, what was your understanding of
4 the business that you had involving Simply Southern
5 with your wife? What was the nature of the
6 business?

7 A Nature?

8 Q Yeah.

9 A More or less I'd be providing, I guess,
10 some type of financial stability for her; if she
11 needed to purchase something, I would just purchase
12 it.

13 Q Got it. So you were providing the
14 financing for the business, and she was actually
15 running the business?

16 A Yes, she was actually running the
17 business.

18 Q Was she the one who made decisions about
19 what name to put the business under?

20 A Yes.

21 Q Do you know how the name Simply Southern
22 was adopted?

23 A No.

24 Q Do you know when it was adopted?

25 A No.

1	Q	These are all questions for Catherine,
2		correct?

3	A	Yes.
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4 Q How much did the business take in a
5 typical year in terms of revenues?

6 A No idea.

7 Q Do you know anything about the business's
8 revenues?

9 A No, sir.

10 Q Do you know anything about whether the
11 business was profitable?

12 A No, sir.

13 Q Do you know whether the business engaged
14 in any marketing or advertising?

15 A No, sir.

16 Q Do you know anything about where the
17 customers were located?

18 A No, sir.

19 Q Was this business your wife's full-time
20 occupation?

17 Q The Simply Southern was not your
18 full-time business was it?

19 A No, it was not.

20 Q What had been your full-time occupation
21 during this 10-year run from 2004 to now?

22 A 2004 to now, aerospace tech engineer.
23 Like I say, right now I'm a traveling engineer for
24 Lockheed Martin.

25 Q Did you have any involvement with the

1 trademark application that became the registration?

2 A To be honest with you, I don't even
3 remember signing for the registration of the
4 trademark. I don't even remember. I don't remember
5 it. If it crossed in front of me, it was just,
6 "Here sign this." And I signed it. And that was
7 the end of it.

8 Q Did you have any communications with your
9 wife about the negotiations to sell the trademark
10 registration?

11 A No.

12 Q She handled that completely?

13 A She handled that completely.

14 Q She also handled completely the trademark
15 application, correct?

16 A Yes.

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CERTIFICATE OF OATH

STATE OF FLORIDA)
COUNTY OF BREVARD)

I, Alexa C. Brickweg, Florida Professional
Reporter, Notary Public State of Florida,
certify that LAWRENCE TAYLOR personally
appeared before me on this 23rd day of August
2016 and was duly sworn.

Personally Known_____

Represented by Counsel_____

Produced I.D._____X_____

Alexa C. Brickweg, FPR
Notary Public and State of Florida at Large
Notary Certificate #CC 860189
(My Commission Expires: 8-7-19)

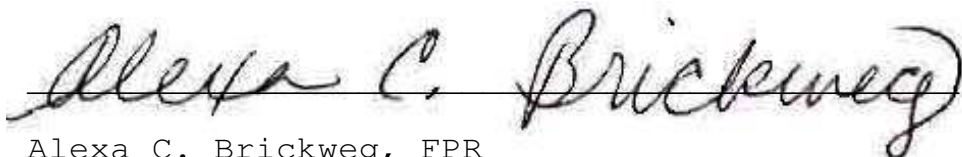
CERTIFICATE OF REPORTER

STATE OF FLORIDA)
COUNTY OF BREVARD)

I, Alexa C. Brickweg, Florida Professional
Reporter, do hereby certify that I was
authorized to and did stenographically report
the deposition of LAWRENCE TAYLOR; that a
review of the transcript was requested; and
that the foregoing transcript, pages 1 through
28 is a true record of my stenographic notes.

I FURTHER CERTIFY that I am not a
relative, employee, or attorney, or counsel of
any of the parties, nor am I a relative or
employee of any of the parties' attorney or
counsel connected with the action, nor am I
financially interested in the action.

DATED this 27th day of August 2016.

A handwritten signature in black ink that reads "Alexa C. Brickweg". The signature is written in a cursive, flowing style. It is positioned above a horizontal line that spans the width of the signature.

Alexa C. Brickweg, FPR
Florida Professional Reporter

WITNESS NOTIFICATION LETTER

August 31, 2016

Lawrence Taylor
6494 Trieda Drive
Melbourne, Florida 32940
taycat@me.com

Re: SIMPLY SOUTHERN FINE ARTS AND HOME DECOR,
LLC
U.S. Legal Support Job No.: 1456600

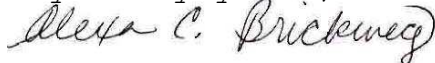
Dear Mr. Taylor,

The transcript of the above-referenced proceeding
has been prepared, and a courtesy copy is enclosed
here for your review.

Any corrections you wish to make to the transcript
should be made on the errata sheet. Please do not
write on the transcript itself.

Please complete review of your transcript within a
reasonable time and return the errata sheet to our
offices. You need not return the entire transcript;
a self-addressed envelope is enclosed for your
convenience.

Very truly yours,



Alexa C. Brickweg, FPR
Florida Professional Reporter
U.S. Legal Support, Inc.
20 North Orange Avenue
Suite 1209
Orlando, Florida 32801
407-649-9193

EXHIBIT 2

“Redline” Comparison of

Prior Counterclaim

to

Applicant’s Amended Counterclaim/Petition for Cancellation

)	
SIMPLY SOUTHERN FINE ARTS)	
AND HOME DÉCOR, LLC,)	Opposition No. 91224533
Opposer/Registrant,)	Application Serial No. 86/450,713
)	
v.)	Counterclaim Cancellation Petition
)	Registration No. 3,335,887
DAZZLE UP, LLC,)	
Applicant/Counterclaim)	
Petitioner.)	
)	

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Dazzle Up, LLC, a limited liability company organized and existing under the laws of the State of North Carolina, with a principal place of business located at 4300 Waterleaf Ct, Greensboro, North Carolina 27410 (hereinafter “Applicant”, “Petitioner” or “Dazzle Up”), believes it has been or will be damaged by the existence of Registration No. 3,335,887 for SIMPLY SOUTHERN (the “Registration”), is also the applicant for application Serial No. 86/450,713 which has been opposed on the basis, in part, of the Registration, and hereby asserts a counterclaim petitioning for the cancellation of the Registration, by and through counsel, pursuant to 15 U.S.C. § 1064(3) and TBMP § 313.

The grounds for this cancellation counterclaim are as follows:

1. Dazzle Up is a limited liability company organized and existing under the laws of the State of North Carolina, with a principal place of business located at 4300 Waterleaf Ct., Greensboro, North Carolina 27410.

2. Dazzle Up is the applicant for application Serial No. 86/450,713 which has been opposed by Simply Southern Fine Arts and Home Décor, LLC which has now filed an amendment reciting that its name is Simply Southern Fine Art and Home Décor, LLC (“Opposer”) on the basis, in part, of the Registration.

3. Opposer has alleged in its First Amended Notice of Opposition that it is a limited liability company formed under the laws of the State of Louisiana. Upon information and belief, Opposer ~~has~~ mis-identified itself.

4. Opposer claims ownership of the Registration in its First Amended Notice of Opposition. Opposer cites the Registration as a basis, in part, for its opposition to Dazzle Up’s application Serial No. 86/450,713.

5. Upon information and belief, Simply Southern Fine Art and Home Décor, LLC (“SSFAHD”) is a limited liability company organized and existing under the laws of the State of Louisiana.

6. SSFAHD is the last listed owner of record for the Registration shown on the on-line TSDR records of the United States Patent and Trademark Office.

7. As shown on the on-line records of the United States Patent and Trademark Office, SSFAHD was purportedly assigned the Registration on May 19, 2015.

8. Opposer requested an extension of time to file its Notice of Opposition on May 26, 2015.

9. The Registration - No. 3,335,887 - is for the mark SIMPLY SOUTHERN for “Retail and computerized online ordering services featuring home furnishings, wall accessories, candles, tableware, housewares, glasswares, floral wreaths, wall shelves, benches, chairs, upholstered furnishings, clocks, wall artwork, primitive notecards, stationery, primitive dolls, wood figurines, pottery, baskets, pillows, rugs, dried florals,” in international class 035.

10. As reflected by the on-line records of the United States Patent and Trademark Office, the most recent prior owner of the Registration was Lawrence Taylor (“Taylor”), an individual who provided an address in Melbourne, Florida.

Abandonment

11. Upon information and belief, Taylor, or another prior owner of the Registration, ceased using with no intention to resume use of, and otherwise abandoned, the use of SIMPLY SOUTHERN for all, or some, of “Retail and computerized online ordering services featuring home furnishings, wall accessories, candles, tableware, housewares, glasswares, floral wreaths, wall shelves, benches, chairs, upholstered furnishings, clocks, wall artwork, primitive notecards, stationery, primitive dolls, wood figurines, pottery, baskets, pillows, rugs, dried florals.”

12. Upon information and belief, Taylor, or another prior owner of the Registration, failed to use SIMPLY SOUTHERN for all, or some, of “Retail and computerized online ordering services featuring home furnishings, wall accessories, candles, tableware, housewares, glasswares, floral wreaths, wall shelves, benches, chairs, upholstered furnishings, clocks, wall artwork, primitive notecards, stationery, primitive dolls, wood figurines, pottery, baskets, pillows, rugs, dried florals,” for at least three consecutive years.

13. The Registration was abandoned, in part or in whole, within the meaning ~~if~~of 15 U.S.C. § 1064(3) & 1127.

14. The Registration should therefore be cancelled, in part or in whole, due to abandonment.

15. Dazzle Up has been damaged and will continue to be damaged if the Registration is permitted to remain on the Principal Register, including because the Registration has been cited by Opposer as a basis for its opposition to Dazzle Up's application Serial No. 86/450,713.

Fraud

16. Dazzle Up incorporates by reference and re-alleges herein paragraphs 1 through 15.

17. The application which became the Registration was filed on February 23, 2004 by Catherine Kolczynski, for a company representing itself in its application as Simply Southern, LLC, organized under the laws of the United States.

18. Mrs. Kolczynski's deposition testimony confirmed that the applicant company was actually a Florida company and that the company was cancelled and not renewed sometime between 2005 and 2007. (C. Taylor Dep. pp. 11:1-15:20.) A copy of excerpts of the sworn deposition of Catherine Taylor f/k/a Catherine Kolczynski is attached as Exhibit A and referred to herein as "C. Taylor Dep."

19. According to the assignment recorded at Reel/Frame 3219/0867 of the United States Patent and Trademark Office, the trademark application was assigned to Lawrence Taylor, an individual, on December 31, 2005.

20. Mr. Taylor testified that he never provided any services under the SIMPLY SOUTHERN mark. (L. Taylor Dep. p. 10:6-10 [“Q: ... were you the one that provided the services under the Simply Southern mark? A: No, sir, I was not.”].) Nor was he aware of any sales made in connection with the Simply Southern business. (L. Taylor Dep. p. 16:22-25 [Q: Mr. Taylor, were sales made in connection with the Simply Southern business? A: Like I say again, I'm not

aware. This operation is handled by Catherine, completely.”].) A copy of excerpts of the sworn deposition of Lawrence Taylor is attached as Exhibit B and referred to herein as “L. Taylor Depo.”

21. Mr. and Mrs. Taylor testified that Mr. Taylor let Catherine Kolczynski, who later became his wife Catherine Taylor, run the Simply Southern business, completely handle the trademark application and even sign his name for him on trademark filings. (L. Taylor Dep. pp. 11:16-12:9, 16:22-25, 19:20-20:2, 20:16-21:3 & 23:4-21; C. Taylor Dep. pp. 46:17-47:5.) For substantial periods of time, Mr. Taylor was not in the country. Although not in the military at the time, he was, in his own words, an “aerospace tech engineer” from 2004 to 2010, often in Afghanistan. (L. Taylor Dep. p. 24:17-24.)

22. Mrs. Catherine Taylor testified that she actually operated the enterprise they called Simply Southern in the 2000s and that it was in Mr. Taylor’s name because, as such, it could be characterized as a veteran-owned, minority-owned business. (C. Taylor Dep. pp. 8:3-12 & 23-25.) He was a “silent partner” for the business, in both of their words, both before they were married and then afterwards. (C. Taylor Dep. pp. 8:13-9:3; L. Taylor Dep. p. 9:17-20).

23. On June 21, 2007, a Statement of Use with Mr. Taylor’s e-signature was filed asserting that he, or his related company or licensee, was using the mark SIMPLY SOUTHERN in commerce on or in connection with all services listed in the application or Notice of Allowance, namely with “retail and computerized online ordering services featuring home furnishings, wall accessories, candles, tableware, housewares, glasswares, floral wreaths, wall shelves, benches, chairs, upholstered furnishings, clocks, wall artwork, primitive notecards, stationery, primitive dolls, wood figurines, pottery, baskets, pillows, rugs, dried florals.”

24. The Statement of Use included a “brochure” as a specimen and asserted that the specimen showed the mark as used in commerce and that the brochure was actually used.

25. The Statement of Use was filed under penalty of perjury.

26. The Statement of Use was false and fraudulent, as demonstrated by the Taylors' deposition testimony.

27. Its falsity had several aspects, including the following.

28. First, the brochure filed as a specimen was not actually in use, contrary to the sworn representation. Mrs. Taylor testified: "A: I would have done the printing, but I had not distributed the brochures. Q: So I'm clear, did you ever distribute the brochures? A: I didn't." (C. Taylor Depo. p. 45:12-19.) Mrs. Taylor testified that while she had plans to lay out the brochures on tables at some retail space she might get or craft fair space, she never did. (Id.)

29. The representations in the Statement of use that the specimen was actually used and that it showed the mark used in commerce were false and fraudulent.

30. Second, the mark was not otherwise in use with the identified services as the identified services were not being rendered by any of the Taylors, any related company, their enterprise or any licensee.

31. The services were identified in the application as "retail and computerized online ordering services featuring [a variety of products]."

32. Mrs. Taylor's testimony was that they never rendered the ordering services, whether of the retail variety or the computerized online variety.

33. Mrs. Taylor testified that her enterprise never had a website through which orders could be made online. She testified:

Q: Did you ever operate a computerized on-line ordering service?

A: I had worked on getting the website up and running for the computerized service, and I was having just issues with back-end problems. So, I didn't – I wasn't able to sell things on-line.

Q: Were you ever able to sell things on-line?

A: No. I was gearing up to try and get the website back up and running. . . . I did have the website up but you couldn't order from it.

...

A: ... I think the website was on the Internet, but you couldn't order from it because the back end wasn't working. So, operational, no. It was physically out in the Internet, but it wasn't operational.

(C. Taylor Depo. pp. 16:17-17:6 & 29:9-15)

34. Although her enterprise had a static website advertising products, orders never could be placed and never could be taken through the website. Therefore, no online ordering service could be rendered, and no online service was ever sold.

35. Mrs. Taylor even testified in response to questioning by Opposer's counsel that her website failed to list a phone number for consumers to call to place orders. She testified: "Q: And if someone would have gone to your website, even though it was not perhaps a fully functional e-commerce site, would such a prospective customer [have] been able to call you and say, I like this item I would like to buy it from you? A: I'm not sure I listed the phone number." (C. Taylor Depo. p. 55:20-25).

36. Further, Mrs. Taylor testified that no one ever called or contacted them to place an order due to the website. She testified: "Q: [Mrs.] Taylor, Mr. Delaune asked you about your website during the time period 2004 to 2010 and whether there was contact information, whether

or not someone could have called and placed an order. Let me ask you: Did anybody ever call or otherwise contact you because of the website and place an order? A: No.” (C. Taylor Dep. p. 57:11-18.)

37. Mrs. Taylor additionally testified that their enterprise never operated a retail store, nor a retail store under the name SIMPLY SOUTHERN.

38. In response to the question “Did you ever operate a retail store,” she answered “I did not operate a retail store” (C. Taylor Depo. p. 16:11-16.)

39. Mrs. Taylor testified that she signed a lease for a space one time in Charlotte, North Carolina, but she “was never able to go in and put products into what kiosk because we were moving.” (C. Taylor Depo. p. 16:11-16.)

40. The enterprise therefore never provided the identified services of providing “retail and computerized online ordering services ...”

41. The phrase “retail and computerized online ordering services ...” refers to the provision of online ordering services, both retail and computerized, much like that provided by Amazon or eBay.

42. Mr. Taylor, the Taylors and their enterprise never rendered such a service.

43. Mrs. Taylor testified that they neither licensed nor authorized anyone else to use SIMPLY SOUTHERN. (C. Taylor Dep. p. 37:20-25.)

44. Mrs. Taylor was also asked by counsel for Opposer whether the brochure filed as the specimen accurately reflected the services purportedly offered by the Taylors, and Mrs. Taylor answered that she was just selling some of the items, and that she “wasn’t really providing a service.” She instead sold “barn stars” and “wreaths.” (C. Taylor Dep. pp. 53:21-54:6.)

45. In contrast to the identified services that were never rendered, Mrs. Taylor testified that she sold a few products on eBay under either the SIMPLY SOUTHERN or SIMPLY SOUTHERN HOME names. She explained that she would, on occasion, purchase products and then post them for re-sale on eBay. (C. Taylor Dep. p. 20:13-14 [“I would order certain products that I liked, and then I would go to sell them on eBay.”].) However, selling on eBay is not the provision of “retail and computerized online ordering services.”

46. A seller utilizing eBay’s online marketplace to sell products she has already obtained is not herself rendering an online ordering service, rather the seller is utilizing eBay’s online service.

47. The use of a putative mark for products sold through eBay in the way described by Mrs. Taylor is only, at most for the seller, the use of a mark for the goods being sold. It is not the use of the mark to identify any service. Indeed, in that instance, eBay – not the product seller – is the only entity actually providing the retail, online service that operates the website, displays the products for sale at the request of a seller, allows a buyer to signal a desire to purchase, and then processes the order including funds transfer.

48. Further, the Taylors’ sales via eBay were, in Mrs. Taylor’s words, “minimal” and “only a few hundred dollars a year” “from 2004 maybe up to 2010,” with no eBay sales after the 2010/2011 time frame except for personal items, such as “clothing” and “kid’s shoes.” (C. Taylor Dep. pp. 18:25-19:18 & pp. 22:2-23:2.) This level of sales is token, sporadic and not substantially continuous, and not sufficient to establish use in commerce for a Statement of Use or Allegation of Use.

49. The SIMPLY SOUTHERN name was not used as a mark for the services identified in the application by Mr. Taylor or his related company or licensee, and thus the representations to the contrary in the Statement of Use was false.

50. Third, the identification of services subject to the Statement of Use included a listing of “featured” products that were never sold nor featured. The averment in the Statement of Use that the services featured such products was false and fraudulent.

51. The identification of services specifically stated that the services featured “home furnishings, wall accessories, candles, tableware, housewares, glasswares, floral wreaths, wall shelves, benches, chairs, upholstered furnishings, clocks, wall artwork, primitive notecards, stationery, primitive dolls, wood figurines, pottery, baskets, pillows, rugs, dried florals.”

52. Mrs. Taylor, however, testified that the only items sold, even under her “minimal” sales on eBay, were “primitive items” consisting of barn stars, country-style curtains and wreaths.

53. The 2007 Statement of Use was false and fraudulent in its statement that the services featured “candles, tableware, housewares, glasswares, wall shelves, benches, chairs, upholstered furnishings, clocks, notecards, stationery, dolls, figurines, pottery, baskets, pillows, rugs [and] dried florals.” Not only were no such services being provided, but such items were also not being provided or “featured” in the services. That representation otherwise was false.

54. Mrs. Taylor testified that much later, in between 2011 and 2013, she sold one clock, one bench, notepads and two wreaths at a neighborhood yard sale. These sales, of course, had not occurred when the 2007 Statement of Use was filed, also were not online, were not the provision of an ordering service, were not through a retail establishment, were not the rendering of a retail service, were “sporadic,” and were mere token sales, in sufficient to show use of a service mark in commerce.

55. The Statement of Use was therefore false and fraudulent.

56. The Statement of Use included the specific false representations identified above.

57. The false representations were material to the registrability of the mark. Without the representations, the United States Patent and Trademark Office could not have validly granted the registration.

58. Mr. Taylor and/or his wife, who e-signed his name for him, knew of the falsity of the representations.

59. Mr. Taylor and/or his wife, who e-signed his name for him, made the false representations with the intention to deceive the United States Patent and Trademark Office and obtain a registration when one should not have been issued for the identified services.

60. On December 4, 2012, Mrs. Taylor filed a Combined Declaration of Use and Incontestability with Mr. Taylor's e-signature asserting that the mark SIMPLY SOUTHERN was is use in commerce on or in connection with all services listed in the registration, namely with "retail and computerized online ordering services featuring home furnishings, wall accessories, candles, tableware, housewares, glasswares, floral wreaths, wall shelves, benches, chairs, upholstered furnishings, clocks, wall artwork, primitive notecards, stationery, primitive dolls, wood figurines, pottery, baskets, pillows, rugs, dried florals." The filing further asserted that the mark had been continuously used in commerce for five (5) consecutive years after the date of registration and was still in use in commerce on or in connection with all services. The filing was made under penalty of perjury.

61. This filing was false and fraudulent in a number of respects.

62. First, as described above, the mark was never in use with the identified services as the identified services were never rendered by any of the Taylors, any related company, their enterprise or any licensee.

63. Not only was it the case that the Taylors never rendered the identified services, but by 2012, even the eBay sales were not occurring. As Mrs. Taylor testified, they had no eBay sales after the 2010/2011 time frame except for personal items, such as “clothing” and “kid’s shoes.” (C. Taylor Dep. p. 18:25-19:18 & p. 22:2-23:2.) Such personal items are not within the identification of services in the Registration.

64. With respect to the sales between 2011 and 2013 of one clock, one bench, notepads and two wreaths at a neighborhood yard sale, those sales were not the provision of the services identified in the Registration. They were not the rendering of an ordering service, were not through a retail establishment, were not the rendering of a retail service, and were merely “sporadic” and token sales, insufficient to show use of a service mark in commerce, much less substantially continuous use in commerce.

65. Second, as with the Statement of Use, the identification of services subject to the Combined Declaration of Use and Incontestability included a listing of “featured” products that were never sold nor featured. The averment in the Combined Declaration of Use and Incontestability that the services featured such products was false and fraudulent.

66. The 2012 Combined Declaration of Use and Incontestability was false and fraudulent in its statement that the services featured “candles, tableware, housewares, glasswares, wall shelves, chairs, upholstered furnishings, stationery, primitive dolls, wood figurines, pottery, pillows, rugs, [and] dried florals.” Not only were no such services being provided, but such items were also neither provided nor featured in the services. The representation otherwise was false.

67. Third, the 2012 Combined Declaration of Use and Incontestability was false and fraudulent in that it asserted that the mark had been continuously used in commerce for five (5) consecutive years after the date of registration on or in connection with all services, when in fact that assertion was false.

68. The Combined Declaration of Use and Incontestability included the specific false representations identified above.

69. The false representations in the Combined Declaration of Use and Incontestability were material to the continued registration of the mark. Without the representations, the United States Patent and Trademark Office would have cancelled the Registration and could not have accepted the Declaration of Incontestability.

70. Mr. Taylor and/or his wife, who e-signed his name for him, knew of the falsity of the representations.

71. Mr. Taylor and/or his wife, who e-signed his name for him, made the false representations with the intention to deceive the United States Patent and Trademark Office, avoid cancellation of the registration, and gain acceptance of the Declaration of Incontestability, when the Registration should have been cancelled.

72. The Registration should therefore be cancelled, in part or in whole, due to abandonment and any one or more of the instances of fraud.

73. Dazzle Up has been damaged and will continue to be damaged if the Registration is permitted to remain on the Principal Register, including because the Registration has been cited by Opposer as a basis for its opposition to Dazzle Up's application Serial No. 86/450,713.

WHEREFORE, Petitioner respectfully requests that this counterclaim/petition be sustained and that Registration No. ~~3,335,887~~ be cancelled, and also that ~~Opposer's First Amended Notice~~

~~of Opposition proceeding be dismissed with prejudice and that Applicant's application be allowed to mature to registration~~
~~3,335,887 be cancelled.~~

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